

REMARKS/ARGUMENTS

Applicants submit the aforementioned amendments and following remarks in response to the Office Action mailed 06/11/2008. Applicants have elected in the present case the species Formula (Ib) S-enantiomer and the neurodegenerative disorder as specifically recited in claim 24. Therefore claims 22 to 24 and 26-31 have been withdrawn pursuant to 37 CFR 1.142(b) and have been cancelled herein. Claims 1-21, 25 and 32 remain in this application as far as they read upon the elected species. Claim 32 has been amended to be dependent upon claims 1 and 5.

In view of the examiner's earlier restriction/election requirement, applicants retain the right to present claims 22, 23 and 26-31 in a divisional application and the subject matter embodied in these claims is being pursued in a divisional application.

Claim Rejections Under 35 USC Section 103(a)

The Examiner has rejected claims 1-21, 24, 25 and 32 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,103,759 (Choi et al) in view of U.S. Patent No. 5,474,990 (to Olney). The Examiner states that Choi et al teaches the elected compound (at col 7, lines 11-15) can be used in stroke and Olney teaches that strokes cause hypoxia-ischemia (from abstract only). Therefore the Examiner claims that it would have been obvious to one of skill in the art at the time of the invention that treating a stroke with the instantly claimed compound would have also treated hypoxia-ischemia due to the stroke. Therefore the Examiner claims that the invention as a whole is *prima facie* obvious. Applicants respectfully disagree for the following reasons. The primary disclosure of Choi et al is that the disclosed compounds are anticonvulsants however the Applicants certainly admit that the word "stroke" is used in the specification at the location indicated by the Examiner. This was apparently done as an afterthought since nowhere else in the specification is there any reference to the treatment of stroke. However of far greater importance is that the present invention is directed to the treatment of neurodegenerative disorders associated with hypoxia-ischemia in general and this is a much broader group of disorders that is implied by the simple term stroke. In fact, Olney itself points out (Column 2, lines 58-61) that "Hypoxia and ischemia are encountered in various conditions such as stroke, cardiac arrest, loss of blood due to an injury, anemia, carbon monoxide poisoning, drowning,

suffocation or perinatal asphyxia.” Therefore hypoxia and ischemia are a broad category of insult that include various and very different mechanisms of causing injury to the nervous system. Therefore, Applicants maintain that the simple inclusion of the term “stroke” in the Choi et al reference does not render the invention as a whole *prima facie* obvious.

Applicants have addressed this issue by specifically removing reference to injury caused by stroke from the claims by canceling claim 24 and amending claims 21 and 25.

Therefore Applicants respectfully request that the rejection under 35 USC 103 be withdrawn.

The Claim Rejections Under 35 USC Section 112

The examiner has rejected claims 1-21, 24, 25 and 32 under 35 USC Section 112 because the Examiner believes that the specification while being enabling for the treatment of neurodegenerative disorders does not provide enablement for the prevention of these disorders.

Applicants have amended claims 1 and 5 to remove the term “preventing” from those claims and therefore from the remainder of the above claims which are dependent on claims 1 or 5.

Applicants respectfully request that the Examiner withdraw the rejection under 35 USC Section 112.

The Double Patenting Rejection

The Examiner has provisionally rejected claims 1-21, 24, 25 and 32 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 and 31-34 of copending Application No. 11/481,601.

Accordingly, Applicants simultaneously are filing herewith a Terminal Disclaimer To Obviate A Double Patenting Rejection

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

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